Remarks/Arguments:

Reconsideration of the application is requested.

Claims 1-20 remain in the application. Claims 1-16 have been withdrawn from consideration.

In item 3 on page 2 of the above-identified Office action, claims 17-20 have been rejected as being fully anticipated by Freyermuth et al. (U.S. Patent No. 6,629,480 B1) (hereinafter "Freyermuth") under 35 U.S.C. § 102.

As will be explained below, it is believed that the claims were patentable over the cited art in their original form and the claims have, therefore, not been amended to overcome the references.

Before discussing the prior art in detail, it is believed that a brief review of the invention as claimed, would be helpful.

Claim 17 calls for, *inter alia*:

a configuration for determining an actual position of the tool before and/or during an insertion of the tool into the clamping chuck.

Claim 17 also calls for, *inter alia*:

a positioning device for positioning the tool in the clamping chuck utilizing information obtained with regard to the actual position of the tool for setting a desired position of the tool inside the clamping chuck.

The Freyermuth reference discloses that a tool can be adjusted precisely with the aid of a device (8), a camera assembly (9), and a console (6) for indicating measurements (column 3, second paragraph). However, Freyermuth does not disclose that a determination of an actual position of the tool occurs or is possible prior to or during the insertion of the tool into the clamping chuck.

Freyermuth discloses that the positioning device (8) is positioned below the tool holding socket (2), which is provided for carrying the **clamping chuck**, in which the tool is to be affixed. In order to be positioned with the aid of the positioning device (8), the tool must already be inserted into the **clamping chuck** so that the device (8) can adjoin the tool

from below in a non-illustrated manner. In this state, it can be measured by the camera assembly (9) and be positioned downstream by the positioning device (8) until the tool is in the desired position. In this way, the length of the tool can be adjusted precisely by the positioning device (8), the camera assembly (9) and the console (6) for displaying measurements, in a state in which the tool is already inserted into the clamping chuck.

As seen from the above given remarks, the reference does not show a configuration for determining an actual position of the tool before and/or during an insertion of the tool into the clamping chuck, as recited in claim 17 of the instant application.

Furthermore, it is not possible for the device disclosed by Freyermuth to determine an actual position of the tool before and/or during an insertion of the tool into a clamping chuck.

More specifically, for Freyermuth to measure the device prior to the insertion of the tool into the clamping chuck, it should have, a holding device for holding the tool in front of the camera (9). Freyermuth only discloses a clamping chuck as a holding device. Freyermuth does not disclose any other holding device. Holding the tool by hand in front of the

camera (9) is out of the question, since the tool would be unstable holding it by hand. Aside from the fact that this would be entirely absurd, in Freyermuth measuring the tool only makes sense after it has been inserted into the clamping chuck and is brought into the desired position. A hand-held tool cannot be measured to its actual position since it unsteady in the hand and the camera cannot be focused on the tool. The tool must be in a fixed position to be measured by the camera (9). In order to measure the tool in Freyermuth, the operator must align the camera (9) such that the desired positioning element, for example a blade of the tool, is caused to lie in the reticule of the camera shown in Fig. 1 of Freyermuth. This is impossible with an unsteady or unstable tool. Besides that, the reading of a measuring value of a continuously moving object neither makes sense nor is it precisely possible. Therefore, in the device disclosed Freyermuth, a measuring of the tool prior to insertion into the clamping chuck is not possible.

Furthermore, in Freyermuth, a measuring of the tool **during** the insertion of the tool into the clamping chuck, i.e. during an inserting movement into the clamping chuck, is also impossible. This is because the ensleeving assembly (13) presses the tool is into the clamping chuck. The ensleeving assembly would be in the way when measuring during a pressing

in of the tool. Moreover, in Freyermuth, measuring the tool during the insertion is impossible because it is impossible for the operator to precisely align the reticule of the camera (9) to the tool during a movement of the tool. In Freyermuth, the camera is only suitable for the measuring a stationary tool. Also, in Freyermuth, the operator would simultaneously have to read the current actual position on the console (6), as a further action, and then decide on the further procedure. This too is impossible as an additional action during movement.

Therefore, Freyermuth does not disclose that the tool is measured prior to or during the insertion into the clamping chuck, as recited in claim 17. Moreover, measuring during the insertion of the tool with the device disclosed in Freyermuth does neither makes sense nor is it possible.

Moreover the reference does not show a positioning device for positioning the tool in the clamping chuck utilizing information obtained with regard to the actual position of the tool for setting a desired position of the tool inside the clamping chuck, as recited in claim 17 of the instant application.

According to this feature, the device for positioning the tool in the clamping chuck must be suitable to set the desired position of the tool while using the information obtained. This is not the case in Freyermuth. Even though Freyermuth discloses a positioning device (8), the positioning device is moved manually by an operator. If necessary, the positioning device is supported by a motor, but it is not capable of automatically positioning the tool into the desired position while using the required information. Also, the positioning device in Freyermuth is not capable of processing any measuring data. Therefore, the positioning device also cannot use measuring data.

Since claim 17 is believed to be allowable, dependent claims 18-20 are believed to be allowable as well.

It is accordingly believed to be clear that none of the references, whether taken alone or in any combination, either show or suggest the features of claim 17. Claim 17 is, therefore, believed to be patentable over the art and since all of the dependent claims are ultimately dependent on claim 17, they are believed to be patentable as well.

In view of the foregoing, reconsideration and allowance of claims 1-20 are solicited.

Applic. No. 10/727,205
Amdt. dated May 2, 2006
Reply to Office action of February 16, 2006

In the event the Examiner should still find any of the claims to be unpatentable, counsel respectfully requests a telephone call so that, if possible, patentable language can be worked out.

If an extension of time for this paper is required, petition for extension is herewith made.

Please charge any other fees which might be due with respect to Sections 1.16 and 1.17 to the Deposit Account of Lerner Greenberg Stemer LLP, No. 12-1099.

Respectfully submitted,

Alfred K. Dassler
52,794

For Applicant(s)

AKD:cgm

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Lerner Greenberg Stemer LLP
Post Office Box 2480
Hollywood, FL 33022-2480
Tel: (954) 925-1100
Fax: (954) 925-1101